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PATENT APPLICATION

ATTORNEY DOCKET NO. ___10006386-2___

### IN THE
### UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):     Michael A. Tremblay        Confirmation No.: 4550

Application No.: 10/720,494        Examiner: Alam, Shahid Al.

Filing Date:    November 24, 2003        Group Art Unit:   2162

Title: System and Method for User Adaptive Software Interface

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

### TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on ___November 21, 2005___ .

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

     (Note: Extensions of time are not allowed under 37 CFR 1.136(a))

     (Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Date of facsimile: December 29, 2005

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Respectfully submitted,

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By

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Rev 10/05 (ReplyBrf)

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. ......................................................................................10/720,494
Filing Date ...........................................................................................November 24, 2003
Inventorship..................................................................................... Michael A. Tremblay
Applicant/Appellant .....................................................................Hewlett-Packard Company
Group Art Unit......................................................................................................2162
Examiner ...........................................................................................Alam, Shahid Al.
Confirmation No. ...................................................................................................4550
Attorney's Docket No. .................................................................................10005386-2
Title:  System and Method for User Adaptive Software Interface

## REPLY BRIEF

To:        MS Appeal Brief - Patents
           Commissioner for Patents
           P.O. Box 1450
           Alexandria, VA 22313-1450


Sir:

This Reply Brief is responsive to the Examiner's Answer mailed November 21, 2005.

This Reply Brief contains items under the following headings, as recommended for reply briefs in MPEP §1208:


I.        Status of claims

II.       Grounds of rejection to be reviewed on appeal

III.      Argument

I.    STATUS OF CLAIMS

The status of claims is unchanged from that which was previously stated in the Appeal Brief.


II.    GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are unchanged from that which was previously stated in the Appeal Brief.

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## III. ARGUMENT

Examiner's Answer (Argument No. 1):

With regard to the Section 102 rejection, Appellant explained in the Appeal Brief that Amro fails to disclose every element of claims 1, 8, 17, 24, 25, 27, 29 and 30. To support this deficiency in his rejection, the Examiner now relies on the doctrine of inherency.

Appellant's Reply:

By maintaining his rejection based on inherency, the Examiner is admitting that the claim recitations are not expressly shown in Amro. Appellant agrees with this admission. However, Appellant respectfully traverses the Examiner's position that Amro inherently discloses these recitations.

In order to support a rejection based upon the inherent limitations that are not expressly disclosed in a prior art reference, more than a summary statement that the recitations are inherent is required. It must be shown that the undisclosed information was known by those of ordinary skill in the art to be present in the reference. *Rosco, Inc. v. Mirror Light Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002).

Instead of presenting some reasoning or other evidence that the claim recitations would have been known by those of ordinary skill in the art, the Examiner summarily states that "[i]nsufficient prior understanding of the inherent properties of a known composition does not defeat a finding of anticipation." Although the Examiner

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reiterates that he is entitled to give claim limitations their broadest reasonable interpretation in light of the specification, the Examiner still fails to explain how his interpretation of Amro is consistent with the interpretation that those skilled in the art would reach. Accordingly, the Examiner has failed to support the rejection based on inherency.

Appellant contends that the claim recitations would not be recognized by persons having ordinary skill in the art as being inherent in Amro. Specifically, claims 1, 8, and 17 recite determining whether events are unrelated. Although Amro analyzes a discrete event on its own to determine whether the event is a spy event or user event, there is no comparison of events with one another. See, col. 2, line 59 – col. 3, line 13. Accordingly, Amro fails to provide any basis which one having ordinary skill in the art would interpret as determining whether events are unrelated.

In addition, claims 1, 8, and 17 recite offering assistance when user events are unrelated. Amro only displays help text when an individual event is a spy event. Again, there is no comparison of events with one another. Accordingly, Amro fails to provide any basis which one having ordinary skill in the art would interpret as offering assistance when events are unrelated.

Claims 24, 27, and 30 further recite a timing relationship. Amro makes no mention of any sort of timing between operating system events. Accordingly, Amro fails to provide any basis which one having ordinary skill in the art would interpret as a timing relationship.

Claims 25 and 29 further recite determining whether a plurality of menus are

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accessed without invoking program tasks. Amro merely discloses enabling a user to enter user-defined help text by clicking inside a window. Accordingly, Amro fails to provide any basis which one having ordinary skill in the art would interpret as determining whether menus are accessed without invoking program tasks.

For at least these reasons, it is unclear to Appellant how the claim recitations are inherent in the disclosure of Amro to one having ordinary skill in the art.

Examiner's Answer (Argument No. 2):

With regard to claims 1, 8, and 17, Appellant explained in the Appeal Brief that Amro does not determine whether a series of events is unrelated. To support this deficiency in his rejection, the Examiner asserts that if the event in Amro "is neither a spy event nor a user event, then it is another type of GUI event (unrelated event) . . . ."

Appellant's Reply:

The Examiner is now relying on GUI events as being the unrelated events. However, this interpretation is inconsistent with the Examiner's position regarding the other claim recitations, as discussed in more detail below for Argument No. 3.

Examiner's Answer (Argument No. 3):

With regard to claims 1, 8, and 17, Appellant explained in the Appeal Brief that Amro does not offer assistance when a series of events is unrelated. To support this deficiency in his rejection, the Examiner asserts that if the event in Amro is a spy event,

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then "displaying a help text corresponding to the current event of the plurality of events."

Appellant's Reply:

Here the Examiner is relying on Amro displaying help text if the event is a spy event. But the claims recite offering assistance when the events are unrelated events. The Examiner previously asserted that the GUI events in Amro are the unrelated events (Argument No. 2). Therefore, the Examiner's rejection is inconsistent.

Examiner's Answer (Argument No. 4):

With regard to claims 24, 27, and 30, Appellant explained in the Appeal Brief that the disclosure relied upon by the Examiner in Amro makes no mention of any timing relationship. To support this deficiency in his rejection, the Examiner asserts that these recitations are disclosed by "Amro's teaching of the beginning of the event handling loop to await the next event and continued until terminated . . . ."

Appellant's Reply:

The event handling loop shown in Figure 2 simply awaits the next event, but there is no disclosure of any timing relationship, much less any mention of analyzing "a timing relationship between events in said series" (claim 24), "calculating an amount of time between operating system events in said series" (claim 27), or "determining a timing relationship between events of said series of events" (claim 30).

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<u>Examiner's Answer (Argument No. 5)</u>:

With regard to claims 25 and 29, Appellant explained in the Appeal Brief that Amro does not disclose determining whether a plurality of menus are accessed by said user without invoking a program action associated with said plurality of menus. To support this deficiency in his rejection, the Examiner asserts that these recitations are disclosed by "Amro's teaching of User One 302 clicks the right mouse button inside the window . . . ."

<u>Appellant's Reply</u>:

The discussion in Amro that the Examiner is relying on states in part:

*"User One 302 indicates his wish to add text to this empty help text window by clicking the right mouse button inside the window. User One's clicking of the right mouse button is recognized by the monitoring program 310 as a user event, via step 204. It searches the user-defined dynamic help text file 314 for a corresponding help text for the start screen, via step 206."* Col. 3, lines 45-51.

There is no disclosure in this discussion of determining whether <u>a plurality of menus</u> are accessed by the user without invoking a program action associated with the plurality of menus.

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Examiner's Answer (Argument No. 6):

With regard to the Section 103 rejection of claims 2-6, 9-14, and 18, Appellant explained in the Appeal Brief that there is insufficient motivation to combine the teachings of Amro and Wu. To support this deficiency in his rejection, the Examiner states the test for combining references several different ways, including (1) "what [the] combined teachings of references would have suggested to those of ordinary skill in art," (2) "reason, suggestion, or motivation . . . may come from references themselves, from knowledge of those skilled in art . . . [etc.]," and "whether there is something in prior art as whole to suggest desirability, and thus obviousness, of making combination."

Appellant's Reply:

Appellant agrees that the Examiner has correctly stated the test for combining references. However, the Examiner has still failed to apply the test for combining references to Amro and Wu. The Examiner's stated motivation for combining the references in his rejection is merely a repetition of _what_ is being combined, rather than an articulation of _why_ the combination should be made. Even in response to Argument No. 6, the Examiner still has not provided any reasoning or other evidence as to how Amro and Wu might satisfy the test for combining references.

Examiner's Answer (Argument Nos. 7 and 8):

Further with regard to the Section 103 rejection, Appellant explained in the Appeal Brief that a prima facie case of obviousness has not been established because the applied

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references (either alone or in combination) do not teach or suggest every recitation of claims 2-6, 9-14, and 18. The Examiner asserts that "a prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art."

Appellant explained that Wu fails to cure the deficiencies of Amro because Wu is not concerned with events occurring on the user's system. The Examiner asserts that Appellant "has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious."

Appellant also explained that Wu does not offer assistance upon determining that a series of events is unrelated. The Examiner asserts that he relies on Amro for determining that a series of events are unrelated, and Wu for prompting a user for search terms and conducting a hierarchical search utilizing these search terms.

Appellant's Reply:

A prima facie case of obviousness requires that the combination of references teach or suggest all the claim limitations. The Examiner has failed to make this showing.

The Examiner's assertion that Appellant has recognized another advantage in Wu is not clear. Appellant has not made any admissions with regard to the disclosure in Wu. In any event, the Examiner still has not explained how Wu is concerned with events occurring on the user's system.

The Examiner's assertion that Wu prompts a user for search terms and conducts a

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hierarchical search utilizing these search terms still fails to explain how Wu offers assistance upon determining that a series of events is unrelated.

Conclusion

Appellant respectfully requests the Board to rule that the rejections of the claims are improper.

Respectfully Submitted,

Dated: Dec. 29, 2005        By: _____ Mark D. Trenner

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